



Image 1653
PATENT
19603/3296 (CRF D-2098C)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	Bogdanove et al.)	Examiner:
Serial No.	:	09/596,784)	G. Bugaisky
Cnfrm. No.	:	3745)	Art Unit:
Filed	:	June 19, 2000)	1653
For	:	HYPERSENSITIVE RESPONSE ELICITOR FROM <i>ERWINIA AMYLOVORA</i> , ITS USE, AND ENCODING GENE)	

REQUEST FOR RECONSIDERATION

MAIL STOP Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the December 19, 2003, office action, applicants respectfully request reconsideration of the bases of rejection asserted against claims 17-28 and 38-39.

The rejection of claims 20-28 as being unpatentable under the judicially created doctrine of obviousness-type double patenting rejection over claims 1-4 and 7-14 of U.S. Patent No. 6,624,139 to Wei et al. ("Wei") is respectfully traversed.

Wei teaches the application of a hypersensitive response elicitor protein or polypeptide to plants whereby the treated plant is rendered resistant to various environmental stresses. Nowhere does Wei teach or suggest use of the presently claimed proteins or polypeptides (of claims 17-19) for purposes of imparting to plants treated therewith either disease resistance (i.e., as in claims 20-22), growth enhancement (i.e., as in claims 23-25), or insect resistance (i.e., as in claims 26-28). Consistent with the failure of Wei to teach or suggest the proteins or polypeptides of claims 17-19, these claims have *not* been rejected for obviousness-type double patenting in view of Wei. Because claims 17-19 are patentably distinct over the claimed invention of Wei, and each of claims 20-28 ultimately depend from claims 17-19, Wei cannot have rendered the use of such proteins or polypeptides obvious.

For this reason, the obviousness-type double patenting rejection of claims 20-28 is improper and should be withdrawn.

The provisional rejection of claims 17-19 and 38-39 as being unpatentable under the judicially created doctrine of obviousness-type double patenting rejection over claims 1 and 93-94 of pending U.S. Patent Application Serial No. 09/879,248 to Fan et al. is respectfully traversed.

Because the provisional rejection is the only remaining rejection of the claimed subject matter, applicants respectfully request that this provisional rejection be withdrawn and the present application be permitted to issue as a patent. *See Manual of Patent Examining Procedure* § 804 at page 800-19 (August 2001). Although applicants have contested the provisional rejection only on procedural grounds, applicants' response is *not* to be considered an admission of any kind concerning the merits of the provisional rejection.

In view of all of the foregoing, applicants submit that this case is in condition for allowance and such allowance is earnestly solicited.

Respectfully submitted,

Date: January 26, 2004


Edwin V. Merkel
Registration No. 40,087

NIXON PEABODY LLP
Clinton Square, P.O. Box 31051
Rochester, New York 14603-1051
Telephone: (585) 263-1128
Facsimile: (585) 263-1600

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

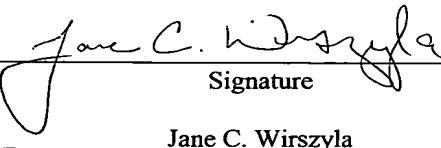
I hereby certify that this correspondence is being:

deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Non-fee Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450

transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) _____.

1/26/04

Date


Signature

Jane C. Wirszyla
Type or Print Name